

### **Remarks/Arguments**

#### **Claims**

Prior to this reply and amendment, claims 1-20 were pending in this application. By way of amendment, claims 11-20 have been cancelled, and claims 21-30 have been added. Following entry of the amendments provided herein, claims 1-10 and 21-30 will be pending. Support for the foregoing amendments can be found throughout the specification as filed, and specifically at page 9 and in the claims as filed. No new matter enters by way of these amendments.

#### **Response to Request for Statement of the Substance of the Interview**

In response to the Examiner's request for a Statement of the Substance of the Interview conducted on May 27, 2004, Applicant notes the following: Examiner and Applicant discussed integrated cards and the state of the art in general. Applicant asserted the novelty and nonobviousness of the claimed methods and devices. The Examiner discussed Eleftheriou and referred to and presented literature that was not on the written record as of the interview date. No agreement was reached.

#### **Response to Detailed Action**

#### **Claim Rejections – 35 U.S.C. 103**

In reply to the 35 U.S.C. 103 rejections on page 2 of the Examiner's Action, Applicant respectfully disagrees with the rejections, and requests reconsideration.

Claims 1-20 stand rejected as obvious over Eleftheriou. Claims 11 through 20 have been cancelled, thereby obviating the rejection of those claims under 35 U.S.C. 103.

The Office Action cites Eleftheriou as a document that alone makes obvious claims 1 through 10. The Office Action asserts that "Eleftheriou discloses that a card can be used for conducting coinless transactions including telephone and laundry services." The Office Action then concludes that the provision of services, although not disclosed by Eleftheriou, would have been obvious.

Respectfully the Applicant notes that claims 1-10 of the present invention comprise providing a single card that can be used to pay for both laundry facilities and telephone service. The Office Action has not indicated where in Eleftheriou such a dual use is either taught or suggested. The sections of Eleftheriou that are cited by the Office Action simply list various uses for the change card taught in Eleftheriou, within which the words "laundry" and

“telephone” appear. Such oblique references do not amount to a legally supportable obviousness rejection.

As a preliminary matter, Applicant respectfully disagrees with the Office Action’s interpretation of Eleftheriou. Eleftheriou is directed to the use of a card that functions in the place of coinage to eliminate coins from transactions. Eleftheriou makes clear that “[t]he charge card . . . is used with paper currency for the purchase of all types of goods and/or services in substantially the same way that coins with paper currency are used.”<sup>1</sup> In other words, the Office Action *has not even indicated where Eleftheriou teaches that a card can be used by itself to specifically purchase either laundry facilities or telephone services*, the combination of which is the essence of claim 1. Applicant requests that the Examiner indicate exactly where in Eleftheriou it is taught to do anything other than use a card for the purpose of obviating the use of coins along with cash.

The Applicant respectfully, but strongly, notes that all the Office Action has appeared to do is produce a single document with the words “card,” “telephone,” and “laundry” found therein. Applicant not only concedes that Eleftheriou discloses these terms, Applicant also acknowledges that cards that offer the individual telephone service or individual laundry service are known in the art and readily available. It is the combination of the two specific services on a single card that differentiates the claimed invention from those known cards and methods.

In addition to *not* indicating where in Eleftheriou the actual purchase of facilities or service is taught, the Office Action also does not indicate where a motivation to combine telephone service and laundry facilities on a single card can be found in Eleftheriou. The Federal Circuit has repeatedly and clearly held that an obviousness rejection that is based on the combination or modification of elements found in the prior art is improper unless a clear motivation to combine or modify those elements is demonstrated. *McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362 (Fed. Cir. 2003).

The only motivation to combine or modify that the Office Action suggests is a motivation that is derived from the desire to “increase profit.” Such a motivation is not one that is legally sufficient, and the Applicant respectfully suggests that if “increased profit” could be used as proper grounds for a motivation to combine or modify elements of the prior art for an

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<sup>1</sup> Column 5, line 23 of Eleftheriou.

obviousness rejection, then any financially profitable combination claim that has been patented to date, of which there are thousands, would be rendered invalid. This cannot be the case.

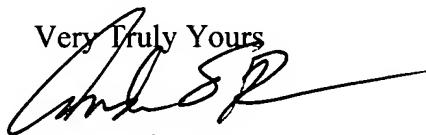
Finally, the Office Action is entirely silent with regard to the limitations introduced in dependent claims 2 through 10. For example, claim 2 introduces the limitation of a check cashing service and claim 3 introduces the limitation of a bill paying service. It is *prima facie* improper for an Office Action to ignore specific limitations in claims, and instead reject, without discussion, all claims over a single insufficient art reference that does not appear to even mention those further limitations. Applicant requests that the Examiner specifically indicate where in the art each of the limitations of the pending dependent claims are disclosed, and where in the art a motivation to combine those features can be found. Lacking this, the obviousness rejection is improper, and Applicant requests that the rejections under 35 U.S.C. 103 be withdrawn.

Further, newly added claims 21 through 30 introduce durability limitations that are neither taught or suggested by Eleftheriou. These limitations, in combination with the integrated card, provide novel and nonobvious methods for providing a useful integrated card that functions to reduce the volume of cards that a typically consumer is forced to carry. Allowance of these newly added claims is, accordingly, requested.

### Conclusion

In view of the amendments and arguments presented herein, as well as the arguments presented at the Interview conducted on May 27, 2004, Applicant believes that all of the pending claims are in condition for allowance and respectfully request that the Examiner withdraw all outstanding rejections and pass this application to issue. The Examiner is encouraged to contact the undersigned at the phone number provided if he believes that such contact will expedite allowance of the claims.

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Very Truly Yours  
  
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